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Paper No. 24

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In re Patent No: 4,654,073	:	SPECIAL PROGRAMS OFFICE DAC FOR PATENTS DECISION GRANTING PETITION
Application No. 06/666,908	:	
Filed: October 31, 1984	:	
Issue date: March 31, 1987	:	
Inventor: Dieter Jahn et al.	:	

This is a decision on the renewed petition filed March 9, 1998, under 37 CFR 1.182, that the recorded terminal disclaimer filed on March 14, 1986, be withdrawn in favor of the terminal disclaimer filed with the petition, and further, that a Certificate of Correction (PTO mistake) be issued to that effect.

The petition is granted to the extent indicated below.

Petitioner again requests that the aforementioned original terminal disclaimer be replaced with that filed August 27, 1997 in that the instant patent term, via the original terminal disclaimer, is limited to the pre "GATT-NAFTA" (i.e., the Uruguay Round Agreements Act (URAA) (1994)) expiration date for U.S. Patent No. 4,422,864 (December 27, 2000), while the latter patent now expires May 20, 2002, as reflected in the newly proffered terminal disclaimer. As such, petitioner asserts, the instant patent contains an erroneous date of expiration, and further, as the error in the patent is not the fault of petitioner, no fees for either the petition, or the requested Certificate of Correction, should be assessed.

The terminal disclaimer filed under 35 USC § 253 and 37 CFR 1.321(c) on March 14, 1986, was relied upon by petitioner to overcome a rejection on the grounds of obviousness-type double patenting involving the claims of commonly owned U. S. Patent No. 4,442,864. The terminal disclaimer was executed by Messrs. Raemisch and Richters, on behalf of the assignee, BASF Aktiengesellschaft, and specified in pertinent part that:

"Your Petitioner, by two duly authorized representatives, hereby disclaims the terminal part of any patent granted on the above-identified application which would extend beyond the expiration date of United States Patent No. 4,422,864 **(expiration date December 27, 2000)**, which is also owned by petitioner...[emphasis added]"

At the time the instant patent was published, the PTO printed thereon the specific expiration date, i.e., December 27, 2000, of U.S. Patent No. 4,422,864 as the end of the term of the instant patent as such date was then identical to the "expiration date," notwithstanding petitioner's concurrent use of the relative term "the expiration date of United States Patent No. 4,422,864."

Due to the changes to 35 U.S.C. § 154(c)(1) contained in Public Law 103-465, § 532, 108 Stat. 4809 (1994), the expiration date of U.S. Patent No. 4,422,864 (as well as the instant patent) is not December 27, 2000; rather it is now May 20, 2002, as correctly noted by petitioner. Thus, the terminal disclaimer of March 14, 1986 creates an ambiguity, in that it sets forth two (2) dates beyond which the terminal date of the above-identified patent is disclaimed: December 27, 2000, and May 20, 2002.

However, in order to resolve the ambiguity in the aforementioned terminal disclaimer filed on March 14, 1986 created by the changes to 35 U.S.C. 154(c)(1) contained in Public Law 103-465, it is not necessary, as requested by petitioner, to substitute the proffered terminal disclaimer for that already recorded. Rather, the correction of the terminal disclaimer date indicated on a patent due to the changes to 35 U.S.C. § 154 contained in Public Law 103-465, § 532, 108 Stat. 4809 (1994) is, if such correction is appropriate, by way of 35 U.S.C. § 254 and 37 CFR 1.322. However, in light of possible future changes to the patent statutes, the proffered Certificate of Correction, as it also recites a specific expiration date, might tend to replicate the problem already encountered herein. As such, the proffered Certificate of Correction will not be accepted.

Nevertheless, the instant file is being forwarded to Certificates of Correction Branch for issuance of a Certificate of Correction to now indicate that, in lieu of the former statement pertaining to the expiration of the term by way of a terminal disclaimer :

--[*] Notice: This patent is subject to a terminal disclaimer.--

Telephone inquiries relative to this decision should be directed to the undersigned at (703) 305-1820.

A handwritten signature in cursive script, appearing to read "Brian Hearn".

Brian Hearn
Special Projects Examiner
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects